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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,335	06/02/2001	Kenneth J. Susnjara	8386.002 US0000	2887
77176 7590 07/20/2009 Novak, Druce & Quigg LLP 1300 I Street, N.W. Suite 1000, West Tower WASHINGTON, DC 20005				
EXAMINER ALVAREZ, RAQUEL				
ART UNIT 3688		PAPER NUMBER		
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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
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8 *Ex parte* KENNETH J. SUSNJARA  
9

10  
11 Appeal 2009-003923  
12 Application 09/872,335  
13 Technology Center 3600  
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16 Decided:<sup>1</sup> July 20, 2009  
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19  
20 Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and  
21 BIBHU R. MOHANTY, *Administrative Patent Judges*.

22  
23 FETTING, *Administrative Patent Judge*.  
24

25  
26 DECISION ON APPEAL

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<sup>1</sup> The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Kenneth J. Susnjara (Appellant) seeks review under 35 U.S.C. § 134 (2002) of a final rejection of claims 68-70, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION<sup>2</sup>

We REVERSE.

THE INVENTION

The Appellant invented software with which a cabinetmaker works with customer A to design and lay out the kitchen, choosing materials, components, and supplies from those offered in the catalog. The software is used to create a sales proposal and quotation which are sent by the cabinetmaker to the customer, who accepts the sales proposal and orders the cabinets from the cabinetmaker. Using the software, the cabinetmaker orders the materials, components, and supplies required for the job. Customer A is then invoiced. The cabinetmakers software is also used to either create shop drawings and manufacturing information for traditional manufacturing or, to produce the *computer numerical control* (CNC) code required to operate a CNC router to produce the required components. Specification 7-8.

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<sup>2</sup> Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed June 3, 2008) and Reply Brief ("Reply Br.," filed August 20, 2008), and the Examiner's Answer ("Ans.," mailed June 20, 2008).

1 An understanding of the invention can be derived from a reading of  
2 exemplary claim 67, which is reproduced below [bracketed matter and some  
3 paragraphing added].

4 67. A method of manufacturing a composite product,  
5 comprising:

6 [1] transmitting

7 from a first party to a remote second party having access  
8 to a computer and a CNC [(computer numerical control)]  
9 machine,

10 software useable upon inputting into said computer to

11 design said composite product,

12 generate a bill of materials for said composite  
13 product in accordance with said design and

14 generate a program of instructions for the  
15 operation of said CNC machine to machine certain  
16 components of said composite product;

17 [2] inputting said software into said computer by said second  
18 party;

19 [3] operating said computer utilizing said software by said  
20 second party to generate

21 a selected design of said composite product,

22 a bill of materials for said designed composite product  
23 and

24 a program for instructing said CNC machine to machine  
25 certain components of said designed composite product;

26 [4] inputting said instructional program into said CNC machine;

27 [5] operating said CNC machine in accordance with said  
28 instructional program to machine said certain components of  
29 said designed composite product;

30 [6] acquiring other of said components of said designed  
31 composite product from a selected source; and

[7] assembling said machined and acquired components to form  
said designed composite product.

#### THE REJECTION

The Examiner relies upon the following prior art:

Carlin                      US 2002/0093538 A1                      Jul. 18, 2002

Claims 67-70 stand rejected under 35 U.S.C. § 103(a) as unpatentable  
over Carlin and Official Notice.

#### ARGUMENTS

There is a single independent claim, *viz.* claim 67. The Appellant contends that Carlin does not provide for the type of software package providing for the design of a composite product, the generation of a bill of materials of such a composite product, the file generation of program instructions for a CNC machine for producing some of the components of the file composite product, the furnishing of such software package by a first party to a second user party, the manner of use of the software package by the user party, nor the use of the user computer output to machine components required to fabricate the designed product. While the Appellant admits that CNC machines may be programmed to perform tasks that otherwise can be performed manually, the Appellant contends that such notice does not teach a modification of the Carlin method to provide for the deficiencies thereof to arrive at the claimed invention. App. Br. 6-7.

The Examiner found that Carlin described the limitations of the claims except for the CNC machine programming and took official notice of the notoriety of CNC machines. Ans. 3-4.

ISSUE

The issue of whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 67-70 under 35 U.S.C. § 103(a) as unpatentable over Carlin and Official Notice turns on whether Carlin describes the generation of a design and bill of materials and would predictably also call for generation of CNC machine instructions.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

*Facts Related to the Prior Art*

*Carlin*

01. Carlin is directed to the computerized composition and display of photorealistic perspective images of real or virtual three-dimensional objects, for the purposes of (i) promoting or selling the depicted objects directly to a consumer, and/or (ii) generating advertising images of the objects. Carlin 1:¶ 0003.

02. The primary net revenue derived by Carlin's promotion, procurement, and image generation service stems from the placing and taking of orders for furniture, and to the lodging of these orders with the manufacturers for direct or indirect shipment to purchaser. Carlin 14: ¶ 0177.

03. Carlin prepares budgets and invoices, and furnishings and swatches may be ordered. Carlin 20: ¶ 0252.

*Facts Related To Differences Between The Claimed Subject Matter And The Prior Art*

04. Carlin fails to describe the generation of a bill of materials and the generation of any computer aided manufacturing instructions.

*Facts Related To The Level Of Skill In The Art*

05. Neither the Examiner nor the Appellant has addressed the level of ordinary skill in the pertinent arts of systems analysis and programming, manufacturing systems, CNC systems, or computer aided design systems. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

*Facts Related To Secondary Considerations*

06. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

*Obviousness*

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

1 In *Graham*, the Court held that the obviousness analysis is bottomed  
2 on several basic factual inquiries: “[1] the scope and content of the prior art  
3 are to be determined; [(2)] differences between the prior art and the claims at  
4 issue are to be ascertained; and [(3)] the level of ordinary skill in the  
5 pertinent art resolved.” 383 U.S. at 17. See also *KSR*, 550 U.S. at 406.  
6 “The combination of familiar elements according to known methods is likely  
7 to be obvious when it does no more than yield predictable results.” *Id.* at  
8 416.

#### 9 ANALYSIS

10 Carlin describes a system that displays objects for sale. FF 01. The  
11 Examiner directs us to Carlin Figs. 3 and 4 and the related text describing  
12 the sale of fabric swatches for the generation of bills of materials. This  
13 portion of Carlin describes purchasing fabric swatches that would be used on  
14 furniture portrayed in Carlin’s system.

15 While the fabric that is to be used on an item would be a component  
16 of a bill of materials, simply describing such a swatch does not generate a  
17 bill of materials as called for in the claim. A bill of materials would list each  
18 item in an assembly and the quantity of the item required to produce a unit  
19 of that assembly. Nothing in Carlin describes or suggests generating such a  
20 list. FF 04. The Examiner found that Carlin described receiving invoices  
21 and that such invoices for products ordered implied such bills of materials.  
22 Ans. 6. But just because an item is invoiced does not mean the item is  
23 placed in a bill of materials. An invoice relates to sales, not manufacturing,  
24 and does not necessarily detail the parts that are used to construct an  
25 assembly.



1 Further, while we agree with the Examiner that the use of CNC  
2 machinery is notoriously well known, we must also agree with the Appellant  
3 that nothing in the art or in the Examiner's official notice of the art shows  
4 that it was predictable to have Carlin's system, which does not have any  
5 suggestion that the information in its system would be sufficiently detailed  
6 for automated manufacturing techniques, perform CNC operations or  
7 generate such instructions for a manufacturer. The generation of such  
8 instructions would imply a detailed collection of manufacturing data that  
9 Carlin does not describe or imply.

10  
11 **CONCLUSIONS OF LAW**

12 The Appellant has sustained its burden of showing that the Examiner  
13 erred in rejecting claims 67-70 under 35 U.S.C. § 103(a) as unpatentable  
14 over Carlin and Official Notice.

15  
16 **DECISION**

17 To summarize, our decision is as follows.

- 18 • The rejection of claims 67-70 under 35 U.S.C. § 103(a) as  
19 unpatentable over Carlin and Official Notice is not sustained.

20  
21 **REVERSED**

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3 Novak, Druce & Quigg, LLP  
4 1300 I Street, N.W.  
5 Suite 1000, West Tower  
6 WASHINGTON, DC 20005

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